

**Amendments to the Drawings:**

The attached sheets of drawings that includes Figs. 1-5, replaces the original sheets including Figs. 1-5.

Attachments: Replacement sheets of drawings

## **REMARKS**

Responsive to the Office Action dated July 28, 2005, Applicant has amended Claim 1.

Accordingly, Claims 1-7 remain pending for prosecution with Claim 1 being independent.

### **I. Drawings Objection**

The drawings were objected to under 37 C.F.R. § 1.83(a) because the photographs fail to provide a showing of any appreciable detail. Applicant has submitted replacement drawings herewith showing structural detail essential for a proper understanding of the disclosed invention under MPEP§ 608.02(d). Applicant respectfully requests entry of the proposed replacement drawings.

### **II. Rejection under 35 U.S.C. § 102(b)**

Claims 1, 4, 6 and 7 have been rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,725,096 to Winnard. For the following reasons, Applicant respectfully requests reconsideration and withdrawal of this rejection.

Winnard does not anticipate the present invention because Winnard fails to disclose each and every element of the invention as claimed. In particular, Winnard fails to disclose a generally circular case for carrying and storing circular saw blades. Winnard also fails to disclose inserts that alter the diameter of at least two storage trays. Rather, Winnard discloses a tool box having a standard rectangular shape and construction with magnetic liners suitable to organize magnetically-attracted tools and components thereof. Accordingly, because Winnard clearly does not teach all of the elements of independent Claim 1, Winnard cannot anticipate the present invention as claimed in Claim 1 and the claims depending therefrom.

### III. Rejections under 35 U.S.C. § 103(a)

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claim combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

#### A. *Rejection of Claims 1 and 4-7 over Winnard*

Claims 1 and 4-7 have been rejected under 35 U.S.C. § 102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over Winnard. For the following reasons, Applicant respectfully requests reconsideration and withdrawal of this rejection.

As discussed above, Winnard does not anticipate the present invention because Winnard fails to disclose each and every element of the invention as claimed. In particular, Winnard fails to disclose a generally circular case for carrying and storing circular saw blades. Winnard also fails to disclose inserts that alter the diameter of at least two storage trays. Rather, Winnard discloses a tool box having a standard rectangular shape and construction with magnetic liners suitable to organize magnetically-attracted tools and components thereof. Accordingly, because Winnard clearly does not teach all of the elements of independent Claim 1, Winnard cannot anticipate the present invention as claimed in Claim 1 and the claims depending therefrom.

Moreover, Winnard fails to teach or suggest the claimed invention. There is no teaching or suggestion of a generally circular case for carrying and storing circular saw blades. To the

contrary, Winnard's standard rectangular tool box with magnetic liners teaches away from the present invention in that the Winnard tool box would not protect the edges of circular blade saws. In fact, the squared edges of the individual drawers in the Winnard tool box could potentially cause damage to a circular saw blade by bumping against the blade's edges. Winnard also fails to disclose inserts that alter the diameter of at least two storage trays. There is no teaching or suggestion Winnard's magnetic liners alter the dimensions of the individual drawers.

Prima facie obviousness requires that there must be some suggestion or motivation, either in the reference itself or in the knowledge generally available to one of ordinary skill in the art, to modify the reference. No such suggestion or motivation exists in Winnard to provide a generally circular case for carrying and storing circular saw blades and inserts contained therein that alter the diameter of at least two of the case's storage trays. Moreover, there is no expectation of success in that Winnard's tool box would not be suitable for safe containment of circular saw blades. Finally, the prior art reference must teach or suggest all the claim limitations. As discussed above, Winnard fails to teach or suggest all of the elements of Applicant's independent Claim 1. Unless all the elements of Applicant's claims are taught by the reference, there can be no success in modifying them.

Thus, at the time the present invention was made, Winnard fails to teach or describe all of the limitations claimed by Applicant in independent Claim 1. Accordingly, independent Claim 1 and the claims depending therefrom are nonobvious under § 103(a).

***B. Rejection of Claims 1-3, 5 and 6 over Piperoux in view of Winnard***

Claims 1-3, 5 and 6 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 1,922,630 to Piperoux in view of Winnard. For the following reasons, Applicant respectfully requests reconsideration and withdrawal of this rejection.

There is no teaching or suggestion in Piperoux of a generally circular case for carrying and storing circular saw blades. The Office Action refers to a circular case shown in Figure 8 of Piperoux as rendering Applicant's invention as obvious. Applicant respectfully traverses this assertion in that Piperoux does not contain a Fig. 8. Piperoux also fails to disclose inserts that alter the diameter of at least two storage trays. In fact, Piperoux fails to disclose the use of inserts at all. Moreover, like Winnard, Piperoux's standard rectangular tool box teaches away from the present invention in that the Piperoux tool box would not protect the edges of circular blade saws. In fact, the squared edges of the individual drawers in the Piperoux tool box could potentially cause damage to a circular saw blade by bumping against the blade's edges.

As discussed above, Winnard also fails to teach or suggest the claimed invention. There is no teaching or suggestion of a generally circular case for carrying and storing circular saw blades. To the contrary, Winnard's standard rectangular tool box with magnetic liners teaches away from the present invention in that the Winnard tool box would not protect the edges of circular blade saws. In fact, the squared edges of the individual drawers in the Winnard tool box could potentially cause damage to a circular saw blade by bumping against the blade's edges. Winnard also fails to disclose inserts that alter the diameter of at least two storage trays. There is no teaching or suggestion that Winnard's magnetic liners alter the dimensions of the individual drawers.

Prima facie obviousness requires that there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references. No such suggestion or motivation exists in Winnard or Piperoux to provide a generally circular case for carrying and storing circular saw blades and inserts contained therein that alter the diameter of at least two of the case's storage trays.

Moreover, there is no expectation of success in that neither Winnard's nor Piperoux's tool box would not be suitable for safe containment of circular saw blades. Finally, the prior art references must teach or suggest all the claim limitations. As discussed above, both Winnard and Piperoux fail to teach or suggest all of the elements of Applicant's independent Claim 1. Unless all the elements of Applicant's claims are taught by the reference, there can be no success in modifying them.

Thus, at the time the present invention was made, Winnard and Piperoux, individually and in combination, fail to teach or describe all of the limitations claimed by Applicant in independent Claim 1. Accordingly, independent Claim 1 and the claims depending therefrom are nonobvious under § 103(a).

#### **IV. Rejection under 35 U.S.C. § 112**

Claims 1-7 have been rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particular point out and distinctly claim the subject matter which applicant regards as the invention. In particular, it was asserted that Claims 1 and 6 recite "the diameter" and Claim 3 recites "the circumference" and that these limitations have insufficient antecedent basis. Applicant has amended Claim 1 to recite a "generally circular case" and respectfully submits that "the diameter" and "the circumference" are inherent features of a circular object and, therefore, antecedent basis is not required. Accordingly, Applicant respectfully requests withdrawal of this rejection.

#### **V. Conclusion**

If any issue regarding the allowability of any of the pending claims in the present application could be readily resolved, or if other action could be taken to further advance this application such as an Examiner's amendment, or if the Examiner should have any questions

regarding the present amendment, it is respectfully requested that the Examiner please telephone Applicant's undersigned attorney in this regard. The Commissioner is hereby authorized to deduct any necessary fees or credit any overpayment of fees in this application to Deposit Account No. 11-0160. Attention is drawn to the correct correspondence address shown below and the correct attorney docket number shown in the header and on the first page of this response.

Respectfully submitted,

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